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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,296	05/30/2001	Tatsushi Nashida	450100-03302	7330
20999 7590 12/30/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER HOSSAIN, FARZANA E				
ART UNIT 2424		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/870,296

Applicant(s)

NASHIDA ET AL.

Examiner

FARZANA E. HOSSAIN

Art Unit

2424

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See *Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6, 8-11.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See *Continuation Sheet*.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2424

Continuation of 3. NOTE: The applicant amended claims 4 and 9 by adding that the recording substitution means obtains advertising information appropriate for user attribute of the requesting origin from another external device by the connection means and the recording substitution means and the b) substitutes said advertising information for the original commercial information included in the recorded program stored in the storage means and replacing advertising content in the recorded program stored in the storage portion with new advertising content received from another external device. Regarding Claim 8, the applicants clarified their claim limitations that the issuing an automatic recording request is in response to the negative output versus issuing the automatic recording substitution request to the external device. These new limitations have to be considered and/or searched.

Claims 4 and 9 were objected to because of the claim language and the specification - the clarification as the applicant amended actually adds new subject matter to the claims that have not yet been rejected in the final rejection because these claims are different from the claims filed 07/23/2008. The examiner also would like to ask the applicant to clarify another external device. The recording center station is the external device that is connected via a wide area network. The claims have a recording substitution means and another external device. Please point to the correct sections that have two external devices to the local storage means for recording when recording advertising information.

Continuation of 11. does NOT place the application in condition for allowance because: Regarding Claims 1-3, the applicant argues that Kuroda does to teach or suggest issuing a recording substitution request in response to a negative result output by the determination means as the user selects a device for the substitution recording (Pages 9-10).

In response to the argument, the examiner respectfully disagrees. Kuroda's request is performed by the television system to issue a recording substitution request to an external device or that the issued request is based on the determination means of negative result (Figure 7, Figure 22, Column 5, lines 60-65). Also, Kuroda discloses that a program is automatically recorded by being moved to the external device if the local storage device runs out of space (Column 12, lines 16-24). Ellis was not used for this limitation.

Regarding Claim 8, the applicant argues that Kuroda controls the temporary storage device and if the programs overflow then the controller deletes the oldest content from the storage device (Pages 13-14). The applicant argues that Lawler does not teach issuing a recording substitution request in response to negative result from a determination portion (Page 14).

In response to the argument, the claim limitation requires there to be a request to record a program on local storage means and if it is determined that space is insufficient to automatically issue a recording request to an external device and Kuroda discloses that a program is recorded and there is not enough space then the program is moved to the external device if the local storage device runs out of space (Column 12, lines 16-24). Lawler discloses automatically issuing a recording request to the external storage device for recording the program via the wide network by the connection means (Column 13, lines 8-12, 26-36). The examiner would also like to point out the applicant has added commas which the examiner is interpreting as to clarify that the recording substitution request is made in response to negative result versus the previous limitation that the recording substitution request was automatically issued to the external storage device and that the clarification is changing the scope of the claim limitation enough to require further consideration and/or search.